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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,603	02/15/2002	Evan Rudolph Zweifel	10014562	2789

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HEWLETT-PACKARD COMPANY  
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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/077,603

Applicant(s)

ZWEIFEL ET AL.

Examiner

Hoang-Vu A. Nguyen-Ba

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 19-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the amendment filed March 14, 2005.

#### *Response to Amendments*

2. Per Applicants' request, claims 1, 6, 9, 12, 15, 20, 23 and 26 have been amended. Claims 1-28 remain pending.
3. The objection to the drawings is withdrawn in view of Applicants' amendments to the drawings to designate these drawings by the legend "Prior Art." The Examiner has fully considered Applicants' arguments that these figures do not purport to be representations of the prior art. However, the Examiner notes that not only these figures do not **explicitly** or **implicitly** illustrate a method for selecting program patches for installation by human or machine patch recipients into computer systems as essentially argued by Applicants in the Remarks at pp. 18-19, these figures also illustrate structure of file and patch system database that is **old** and **known** (see specification, pp. 5-6). Therefore, for at least these two reasons, these figures should be designated by the label "Prior Art" because only that which is old is illustrated according to MPEP § 608.02(g).
4. The objection to claims 12 and 26 is withdrawn in view of Applicants' amendments to correct a minor informality.
5. The rejection of claims 6, 9, 20 and 23 under 35 U.S.C. § 112, second paragraph as being indefinite is withdrawn in view of Applicants' amendments to these claims to remove the permissive language "may be."
6. The rejection of claims 6, 7, 9, 10, 20, 21, 23 and 24 under 35 U.S.C. § 112, second paragraph as being indefinite is withdrawn in view of Applicants' showing of evidence from the specification that the terms "all" and "limited" are clearly defined.

7. The rejection of claims 3 and 17 under 35 U.S.C. § 112, second paragraph as being indefinite is withdrawn in view of Applicants' showing of evidence from the specification that the phrase "highly reliable" is clearly defined.
8. The rejection of claims 4 and 18 under 35 U.S.C. § 112, second paragraph as being indefinite is withdrawn in view of Applicants' showing of evidence from the specification that the phrase "acceptable reliability" is clearly defined.
9. The rejection of claims 3, 4, 17 and 18 under 35 U.S.C. § 112, second paragraph as being indefinite is withdrawn in view of Applicants' amendments to the parent claims and specification to provide antecedent basis to the term "patch tree" recited in claims 3, 4, 17 and 18.
10. The rejection of claims 15-28 under 35 U.S.C. § 101 is withdrawn in view of Applicants' amendments to the claims to direct these claims to statutory subject matter.

### ***Response to Arguments***

11. Applicant's arguments filed March 14, 2005 have been fully considered but they are not persuasive. The following is an examiner's response to Applicants' arguments.

- a. Rejection of Claims 1-4 and 15-18 Based Upon under 35 U.S.C. § 102(a)  
In View of Admitted Prior Art Disclosed in Figure 15

In response to Applicants' arguments that Figures 2-4 and 15 do not constitute "prior art," the examiner respectfully direct Applicants' attention to the examiner's rationale for maintaining that these figures are prior art in paragraph 3 of the section "Response to Amendments."

In response to Applicants' arguments that independent claims 1 and 15 and all the dependent claims 2-14 and 16-28 are not anticipated by the teachings of the present patent application (note that the examiner interprets

that Applicants' assertion is that these claims are not anticipated by the prior art instead of by the teachings of the present patent application), the examiner notes the following:

- i. Applicants allegedly submit that independent claims 1 and 15 specifically require that the patch chain is scanned from the position of that at least one patch in a direction toward the root of the patch tree. Applicants further challenge the examiner to show where in Figures 2-4 and 15 and in introductory paragraphs [0002] and [0009] he finds it taught that "a computerized search of a patch tree is to be conducted from a known patch towards the root of the patch tree." In response, the examiner notes that none of the above-mentioned limitations are specifically recited in the independent claims and limitations in the specifications cannot be read into the claims for the purpose of distinguishing the claims over the teachings of the prior art. If Applicants assert that these limitations describe an entirely new approach to locating patches and are distinct from that of the parent application, they are encouraged to specifically claim this subject matter in the independent claims.
- ii. the body of the independent claims does not specifically recite any steps that **select** patches for installation on a computer system or any steps that specifically **install** these selected patches or any steps that provide any information that can help one to **use** a computer to perform these steps. The examiner also notes that the preamble of independent claim 1 only recites the intended use of the method, i.e., selecting program patches for installation by human or machine patch recipients into computer systems, where the patches are organized into patch trees each having a root. As such, these limitations shall not be given patentable weight.

Accordingly, the rejection of Claims 1-4 and 15-18 under 35 U.S.C. § 102(a) as being anticipated by admitted prior art is considered still proper and is thus maintained.

b. Rejection of Claims 5-14 and 19-28 Based Upon 35 U.S.C. § under 35 U.S.C. § 103(a) In View of Admitted Prior Art Disclosed in Figure 15 and U.S. Patent No. 5,809,230 (Pereira)

After reconsideration of the features recited in these dependent claims, the examiner notes that these features are not allowable when taken individually but would be allowable when combined with all the limitations of the independent claims, if these independent claims are rewritten to incorporate features that purport to describe an entirely new approach to locating patches discussed above in paragraph 11.a.i.

The rejection of Claims 5-14 and 19-28 under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in view of Pareira is thus withdrawn.

***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-14 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Under the most recent Federal Circuit cases, **transformation of data by a machine** (e.g., a computer) is statutory subject matter provided the claims recite a

“practical application, i.e., ‘a useful, concrete and tangible result.’” State St. Bank & Trust C o. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998).

In this instance, claim 1 does not appear to recite any **transformation of data** from one state into another state because the recited steps are merely **searching**, **examining**, and **presenting** patches.

Furthermore, the Office’s interpretation of claims 1-14 is that these claims do not expressly or implicitly require performance of any steps by a machine, such as a general purpose digital computer. Structure will not be read into the claims for the purposes of the statutory subject matter analysis although the steps might be capable of being performed by a machine.

### ***Claim Rejections – 35 U.S.C. § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

15. Claims 1-4 and 15-18 are rejected under 35 U.S.C. § 102(a) as being anticipated by the admitted prior art (APA) of Figures 2-4, 15 and pages 1-4 of applicants’ background.

### **Claims 1 and 15**

APA discloses at least:

*searching for a patch that corrects a particular defect or that has a particular property or both* (see at least Figure 15 and related discussion in the specification);

*examining additional patches, if any, sharing the same patch chain as any such patch found as a result of the search and occupying a position on the shared patch chain between that of any such patch found and the root of the patch chain* (see at least Figure 15, e.g., patch tree 1504 and related discussion in the specification); and

*presenting one or more patches, including any such patch found and examined patches that satisfy one or more specified conditions determined by the nature of each patch and the identity of the patch recipient* (see at least Figure 15, e.g., “(2)” in “PATCH\_10(2)” of patch tree 1504 and related discussion in the specification).

#### **Claims 2 and 16**

The rejection of base claims 1 and 15 are incorporated. APA further discloses *wherein at least one specified condition to be satisfied by presented patches is reliability adequate to the requirements or attributes or both of a given patch recipient* (see at least Figure 15, e.g., “(2)” in “PATCH\_10(2)” of patch tree 1504 and related discussion in the specification).

#### **Claims 3 and 17**

Rejections of base claims 1, 15 and intervening claims 2, 16 are incorporated. APA further discloses *wherein any patch found is presented along with the patch closest to the root of the patch tree having the same or greater reliability to a recipient in need of highly reliable patches* (see at least Figure 15, e.g., “(2)” in “PATCH\_10(2)” of patch tree 1504 and related discussion in the specification).



### **Claims 4 and 18**

The rejection of base claim 1 and 15 are incorporated. APA further discloses *wherein any patch found and any patch closest to the root of the patch tree having acceptable reliability is presented to a recipient in need of patches having acceptable reliability* (see at least sections [0007] and [0008]).

### ***Allowable Subject Matter***

16. Claims 5-14 and 19-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is an examiner's statement of indication of reasons for allowance:

The admitted prior art fails to teach or suggest the combination of the features recited in the dependent claims with those of the independent claims if the latter are rewritten to incorporate the novelty feature discussed in paragraph 11.a.i. The features recited in the dependent claims are however not allowable when they are considered individually.

### ***Conclusion***

18. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 7:15 to 17:15.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANTONY NGUYEN-BA**  
**PRIMARY EXAMINER**

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June 8, 2005

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